

REMARKS

The paper is in response to the Office Action mailed January 29, 2010 ("the Office Action"). The foregoing amendment amends claims 12, 15, and 18. Claims 1, 2, 4-10, and 12-29 remain pending, of which claims 1, 15, and 28 are independent. Applicants respectfully request reconsideration of the application in view of the above amendments to the claims and the following remarks. For Examiner's convenience and reference, Applicants present remarks in the order that the Office Action raises the corresponding issues.

In connection with the prosecution of this case and any related cases, Applicants have, and/or may, discuss various aspects of the disclosure of the cited references as those references are then understood by the Applicants. Because such discussion could reflect an incomplete or incorrect understanding of one or more of the references, the position of the Applicants with respect to a reference is not necessarily fixed or irrevocable. Applicants thus hereby reserve the right, both during and after prosecution of this case, to modify the views expressed with regard to any reference.

Please note that Applicants do not intend the following remarks to be an exhaustive enumeration of the distinctions between any cited references and the claims. Rather, Applicants present the distinctions below solely by way of example to illustrate some of the differences between the claims and the cited references. Finally, Applicants request that Examiner carefully review any references discussed below to ensure that Applicants' understanding and discussion of any reference is consistent with Examiner's understanding.

Unless otherwise explicitly stated, the term "Applicants" is used herein generically and may refer to a single inventor, a set of inventors, an appropriate assignee, or any other entity or person with authority to prosecute this application

I. Rejection Under 35 U.S.C §103(a)

The Office Action rejects the claims under 35 U.S.C §103(a) as follows:

- Claims 1, 2, 15, 16, 22, 23, 25, 27, and 28 are rejected as being unpatentable over *Bender* (U.S. Patent Publication No. 2002/0041568) in view of *Rajaram et al.* (U.S. Patent Publication No. 2003/0033599);
- Claims 4-7, 24, and 26 are rejected as being unpatentable over *Bender* in view of *Rajaram*, as applied to claims 1-3, 15-16, 22, 23, 25, 27, and 28 above, and in further view of *Picazo, Jr. et al.* (U.S. Patent No. 6,006,275);
- Claims 8-10, 17-20, and 29 are rejected as being unpatentable over *Bender* in view of *Rajaram*, as applied to claims 1-3, 15-16, 22, 23, 25, 27, and 28 above, and in further view of *Rose et al.* (U.S. Patent Publication No. 2003/0120925);
- Claims 12-14 are rejected as being unpatentable over *Bender* in view of *Rajaram* and *Rose*, as applied to claims 8-10 and 17-20 above, and in further view of *Benjamin et al.* (U.S. Patent No. 5,668,654); and
- Claim 21 is rejected as being unpatentable over *Bender* in view of *Rajaram* and *Rose*, as applied to claims 8-10 and 17-20 above, and in further view of *Fernandes et al.* (U.S. Patent Publication No. 2003/0218066).

Applicants respectfully traverse the rejection in light of the following remarks.

To support an obviousness rejection, MPEP §2143.03 requires “all words of a claim to be considered.” Further, the Board of Patent Appeal and Interferences recently confirmed that a proper, post-KSR obviousness determination requires “a searching comparison of the claimed invention—including all its limitations—with the teaching of the prior art.” *In re Wada and Murphy*, Appeal 2007-3733 (BPAI 2008), citing *In re Ochiai*, 71 F.3d 1565, 1572 (Fed. Cir. 1995) (emphasis added). Moreover, as the Supreme Court recently stated, “there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *KSR Int’l v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007) (quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) (emphasis added)).

A. Independent Claim 1

In rejecting claim 1, the Examiner relies on a combination of teachings from *Bender* and from *Rajaram*. However, as noted in Applicants' previous response, the prior art does not teach any reason, such as a benefit or advantage, that would have lead one of ordinary skill in the art to combine *Bender* and *Rajaram*. Moreover, one of ordinary skill in the art would have no reason to look to *Rajaram*, which deals with updating software in a wireless phone, to solve the problem of updating routing tables, addressed in *Bender*. In the response to arguments section the Examiner attempts to address the foregoing points by advancing various reasons that would have purportedly motivated the combination of *Bender* with *Rajaram*. However, these reasons are based on hindsight speculation.

Claim 1 recites a communication module comprising, among other things, "a network interface, wherein the communication module performs [a] primary function over [a] network via the network interface," and "a bi-directional interface, wherein the bi-directional interface comprises at least one optical interface and is adapted to provide a local wireless access to the first digital storage unit ...wherein the local wireless access enables the content of the first digital storage unit to be modified to change the primary function of the communication module." Thus, the communication module of claim 1 has two interfaces—a "network interface" and a bi-directional "optical interface," each interface having a different purpose.

The Examiner alleges that an access point 220A in *Bender* corresponds to the claimed communication module and that an Ethernet network 280C corresponds to the claimed network interface of the communication module. See *Office Action* at 2 and 3. The Examiner concedes that "Bender does not appear to explicitly disclose...a bi-directional interface..." but relies on *Rajaram* as disclosing an infrared interface purported to correspond to the claimed "bi-directional interface." See *id.* at 3, 4. According to the Examiner, "it would have been obvious to...include a wireless interface on the routers [of Bender] since the network of Bender is a mobile one." See *id.* at 4.

However, the fact that the *Bender's* network is a "mobile one" does not imply any need or motivation to provide *Bender's* stationary routers with the infrared interface found on the *Rajaram's* wireless phones. In fact, although *Rajaram* mentions use of a close range infrared

interface for updating software on a phone, such use is characterized as "inconvenient" compared to using a remote interface, such as an airlink interface. See *Rajaram* at ¶ 5 ("The costs involved in such [close proximity] updates are extensive...[and] the customer is inconvenienced and likely to be irritated.")

The Examiner also attempts to support the *Bender-Rajaram* combination by asserting various conveniences that would be attained, such as not needing "a direct wired connection" for access and updates and not having to "find a hardwired computer with a connection to a router," particularly if "the router is closer than the nearest hardwired computer." See *Office Action* at 33. Moreover, the Examiner alleges that the reason for combining *Bender* and *Rajaram* is based on "common knowledge and common sense of the person of ordinary skill in the art." See *id.*

However, the foregoing assertions of conveniences and "common knowledge" are not recognized in the prior art. In fact, as noted above, *Rajaram* characterizes a close proximity interface as inconvenient compared to a remote airlink interface. Therefore, *Rajaram* constitutes evidence that one of ordinary skill in the art would not have been lead by "common knowledge" to combine the references in the proposed manner. Accordingly, the Examiner's reasons proposing the combination of *Bender* with *Rajaram* are based on hindsight speculation.

Furthermore, the Examiner asserts that knowledge of a motivation for combining *Bender* with *Rajaram* is "not gleaned only from applicant's disclosure." See *Office Action* at 34. In support of this assertion, the Examiner asserts "methods for directly and wirelessly communicating with a device (much like walk-up printing) are known to one of ordinary skill in the art at the time of the invention." See *id.* However, even if such methods were "known," that fact does not imply or suggest the obviousness of modifying *Bender's* router to implement such "known" methods.

For at least the foregoing reasons, Applicants respectfully submit that no *prima facie* case of obviousness has been established with respect to claim 1. Moreover, because claim 1 is patentable as discussed herein, the claims that depend from claim 1 are patentable for at least the same reasons.

B. Independent Claim 15

Claim 15 recites at least some features generally similar to those of claim 1 discussed above. For example, claim 15 recites use of a network interface and a bi-directional interface, although different uses are recited for the bi-directional interface. Moreover, the Examiner applies the same or a similar combination of *Bender* and *Rajaram* in rejecting claim 15 as is applied to reject claim 1. Therefore, the rejection of claim 15 is submitted to be deficient for at least the same reasons discussed above with respect to claim 1.

Furthermore, claim 15, as amended, is submitted to be allowable over the prior art for additional reasons, as well. For example, claim 15 has been amended to recite: “receiving an access request signal in the module from a portable software carrier unit; [and] receiving an authorization signal from an authorization unit, the authorization signal identifying the module and instructing the module to grant access to [a] portable software carrier unit.” (Emphases added.) Thus, claim 15 recites reception of two distinct signals—an “access request signal” and an “authorization signal.” In contrast, the prior art fails to teach or suggest the foregoing signals.

In rejecting other claims that recite “an authorization signal” (e.g., claim 8), the Examiner concedes that *Bender* and *Rajaram* are deficient. *See Office Action* at 23. Instead, *Rose* is relied on for its teaching of a wireless one-way authentication method that involves use of an “authorization signal.” *See id.* More specifically, the Examiner identifies a “secure identifier,” which an individual uses to request access to an external device, as corresponding to the claimed “authorization signal.” *See id.* However, if the access requesting “secure identifier” corresponds to the claimed “authorization signal,” it is unclear what signal would correspond to the claimed “access request signal” of amended claim 15.

Conversely, should the Examiner determine that the “secure identifier” of *Rose* more closely corresponds to the claimed “access request signal,” it is unclear what signal would correspond to the claimed “authorization signal.” For example, there appears to be no mention in *Rose* of any “authorization signal” or the like that “identifies” the module to which access is requested and that “instruct[s] the module to grant access,” as claimed. According to *Rose*, access is simply “allowed” if the secure identifier is successfully verified. *See Rose* at ¶ 39.

Claim 15, as amended, also recites "exchanging data between the module and the portable software carrier unit via a bi-directional optical interface of the module while the module performs the primary function over the network via a network interface of the module." (Emphasis added.) The foregoing emphasized limitation of claim 15 is mentioned in the Office Action once, but only to note its absence from the teachings of *Bender*: "*Bender* does not appear to explicitly disclose the communication module being adapted to perform 'a secondary function'... while performing the primary function over the network...." See *Office Action* at 7. The Examiner relied on another reference—*Rajaram*—in the rejection of claim 15. However, the Examiner failed to even assert, much less establish, that *Rajaram* cures the foregoing deficiency of *Bender*.

Therefore, claim 15 is submitted to be allowable over the prior art for the foregoing additional reasons and withdrawal of the rejection of claim 15, and its corresponding dependent claims, is respectfully requested.

C. Independent Claim 28

Claim 28 recites at least some features generally similar to those of claim 1 discussed above. For example claim 28 recites a network interface and a bi-directional interface, although different uses are recited for the bi-directional interface. Moreover, the Examiner applies the same or a similar combination of *Bender* and *Rajaram* in rejecting claim 28 as is applied to reject claim 1. Therefore, the rejection of claim 28 is submitted to be deficient for at least the same reasons discussed above with respect to claim 1. Accordingly, withdrawal of the rejection of claim 28, and its corresponding dependent claims, is respectfully requested.

II. Charge Authorization

The Commissioner is hereby authorized to charge payment of any of the following fees that may be applicable to this communication, or credit any overpayment, to Deposit Account No. 23-3178: (1) any filing fees required under 37 CFR § 1.16; (2) any patent application and reexamination processing fees under 37 CFR § 1.17; and/or (3) any post issuance fees under 37 CFR § 1.20. In addition, if any additional extension of time is required, which has not otherwise

been requested, please consider this a petition therefor and charge any additional fees that may be required to Deposit Account No. 23-3178.

CONCLUSION

In view of the foregoing, Applicants submit that the pending claims are allowable. In the event that Examiner finds remaining impediment to a prompt allowance of this application that may be clarified through a telephone interview or overcome by an Examiner's Amendment, Examiner is requested to contact the undersigned attorney.

Dated this 29th day of April 2010.

Respectfully submitted,

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